

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-12 are pending in this application. Claims 3, 7, and 11 have been amended to be rewritten in independent form and clearly include no new matter.

The outstanding Office Action presents a repeated rejection of Claims 1, 4, 5, 8, 9, and 12 under 35 U.S.C. §103(a) as being unpatentable over Xu et al. (U.S. Patent No. 6,909,690, Xu) in view of Khaleghi et al. (U.S. Patent No. 6,975,609, Khaleghi) and a repeated rejection of Claims 2, 6, and 10 under 35 U.S.C. §103(a) as being unpatentable over Xu in view of Khaleghi and in further view of Peisa et al. (U.S. Patent No. 6,850,540, Peisa).

Initially, Applicants acknowledge with gratitude the indication of allowable subject matter as to Claims 3, 7, and 11. As these claims are rewritten in the required independent form, allowance of Claims 3, 7, and 11 is respectfully requested.

With regard to rejection of Claims 1, 4, 5, 8, 9, and 12 under 35 U.S.C. §103(a) as being unpatentable over Xu in view of Khaleghi, it is noted that the Supreme Court requires any rejection made under 35 U.S.C. § 103 to include a determination of the scope and content of the prior art followed by **correctly ascertaining the differences between the prior art and the subject matter of the claims at issue.** See *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). In determining the scope and content of the prior art and ascertaining the differences between the prior art and the subject matter of the claims at issue, the precedent of the U.S. Court of Appeals for the Federal Circuit as to interpreting the teachings of the prior art references at issue is clearly binding on the PTO. See *In re Lee* 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“As discussed in *National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp.*, 817 F.2d 74, 75 (9th Cir. 1987), an agency is ‘not free to refuse to follow circuit precedent.’”).

Accordingly, in determining the scope and content of the teachings and suggestions of Xu and Khaleghi, the PTO analysis must comport to the precedent of the U.S. Court of Appeals for the Federal Circuit as to properly interpreting the teachings of the prior art references.

Claim 1 requires more than “a mobile communication system including a base station and also including packet users and an associated packet switching system producing packet calls and other users and an associated circuit switching system producing other calls” as admitted at the top of page 4 of the outstanding Action. For example, Claim 1 requires “calculating a correction value in accordance with a number of actively connected packet users of said packet switching system,” not “calculating a correction value B2 in accordance with a number, m, of actively connected voice-band data calls” as set forth at the bottom of page 3 of the outstanding Action. There is no explanation in the outstanding Action as to how the PTO came to the conclusion that the claimed calculating “in accordance with a number of actively connected packet users of said packet switching system” can be equated to the Xu determination of the part of the total bandwidth (B1 and B2 are added to determine total bandwidth B) that is associated with the number (m) of “actively connected voice-band data calls,” particularly in light of the admission at the top of page 4 of the outstanding Action that Xu does not teach “packet users and associated packet switching system producing packet calls.” As explained by the Court in *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) the PTO must point to **relevant reference based evidence** to support the conclusion that seemingly different language is actually equivalent language.

Also, the determination of the bandwidth B2 associated with the number (m) of “actively connected voice-band data calls” has already been relied upon as part of the teaching in Xu total bandwidth B (noted at page 3 of the outstanding Action to be “based on

the number of currently active voice **and voice band data calls**” (emphasis added)) that is urged by the outstanding Action to correspond to the Claim 1 required “measuring a resource use condition based upon existing connections provided by the connecting step.” Clearly, the bandwidth B2 of Xu is already incorporated into the total bandwidth B ($B = B1n = B2m$ as noted at col. 7, line 24 of Xu) relied on as to the Claim 1 required “resource use condition based upon the existing connections provided by the connecting step” and cannot then be surgically removed to also be relied upon to correspond to the Claim 1 step requiring “calculating a correction value in accordance with a number of actively connected packet users of said packet switching system.” Moreover, Xu does not teach or suggest any adjustment to the restriction on the acceptance of a new call that is clearly based on the Xu comparison of the total bandwidth B to provisional bandwidth B’ because bandwidth B2 is part of bandwidth B, not an adjustment to change the effective bandwidth B as urged at the top of page 4 of the outstanding Action. Thus, nothing in Xu reasonably teaches or suggests the Claim 1 required “adjusting the restriction of said new call acceptance in accordance with said call acceptance threshold value in the restricting step by using the correction value calculated in the calculating step.”

Moreover, the systems of Xu and Khaleghi are clearly not compatible and Xu cannot be modified by the teachings of Khaleghi without “substantial reconstruction and redesign of the elements shown in Xu as well as a change in the basic principle under which the Xu constructions was designed to operate.” *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) as authority that prohibited this “substantial reconstruction and redesign of the elements shown in [the primary reference]” and such “a change in the basic principle under which the [primary reference] construction was designed to operate.”

In this regard, the teachings in Khaleghi note that there are both voice and data users which require different power reserves and that “AVE” is determined based upon total traffic

expressed in terms of equivalent voice users. See col. 6, lines 59-67. In detail, the Khaleghi approach is to calculate powers for voice and data callers and then dynamically allocate resources between these voice and data users as further explained at col. 8, lines 25-31.

Accordingly, new voice user admission in Khaleghi depends on residual resources that would remain for data users after grant of access as explained at col. 8, lines 55- 61. Similarly, the Khaleghi granting of data call access is explained at col. 9, lines 36-38, as being “based on the residual ‘reserved’ power of data calls rather than the actual power consumed by data calls.” As noted above, Xu teaches comparison of the total bandwidth B to provisional bandwidth B,’ where bandwidth required for given numbers of both voice calls and voice-band data calls are taken into account to determine “B.”

Clearly, the teachings of Xu and those of Khaleghi are not related and cannot be “combined” in any manner that will not destroy the completely different operating principle of the other.

Claim 5 is directed to a system similar to the subject matter of Claim1 in that the Claim 5 system elements are recited to provide functions that correspond to the steps of method Claim 1. Accordingly, Claim 5 patentably defines over Xu at least for the reasons noted above as to these Claim 1 steps. In addition to reciting these corresponding functions, Claim 5 also recites system elements that are clearly not taught by Xu and that have not been properly analyzed as differences in light of the above noted decision of *Graham v. John Deere*. For example, there must be a “transmitting/receiving section” that will “connect with the packet users and the other users to provide multiple access calls with shared wireless resources” that has not been properly treated as being a clear difference from what is taught by Xu.

Furthermore, Claim 9 is directed to a base station device that is defined by the use of “means plus function” recitations governed by the sixth paragraph of 35 U.S.C. 112 as to

broadest reasonable interpretation. *See in re Donaldson Co.*, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir.1994) (in banc) that mandates that the broadest reasonable interpretation that an examiner may give means-plus-function language in a pending application is the interpretation statutorily mandated by the sixth paragraph of 35 U.S.C. §112. The PTO reviewing court, in *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997), requires that the PTO must construe the scope of the structures disclosed in the specification for the claimed "means" and explain how these "means" structures as disclosed in the specification are structurally equivalent to the structures embodied in Xu, or Xu as modified by Khaeghi, as to the Claim 9 "transmitting/receiving means," "resource measurement means," "call acceptance restriction means," "correction value calculation means," and "adjustment means." The *Gechter v. Davidson* decision also requires the PTO to define the exact function of each of these claimed "means," as well as to explain how Xu, or Xu as modified by Khaeghi, teaches the identical function.

Accordingly, as no valid *prima facie* case of obviousness is set forth in the outstanding Action as to the rejection of independent Claims 1, 5, and 9, and as Claim 4 depends from Claim 1 and includes all the above-argued features thereof, Claim 8 depends from Claim 5 and includes all the above-argued features thereof, and Claim 12 depends from Claim 9 and includes all the above-argued features thereof, withdrawal of the improper rejection of Claims 1, 4, 5, 8, 9, and 12 under 35 U.S.C. §103(a) as being unpatentable over Xu in view of Khaleghi is submitted to be in order.

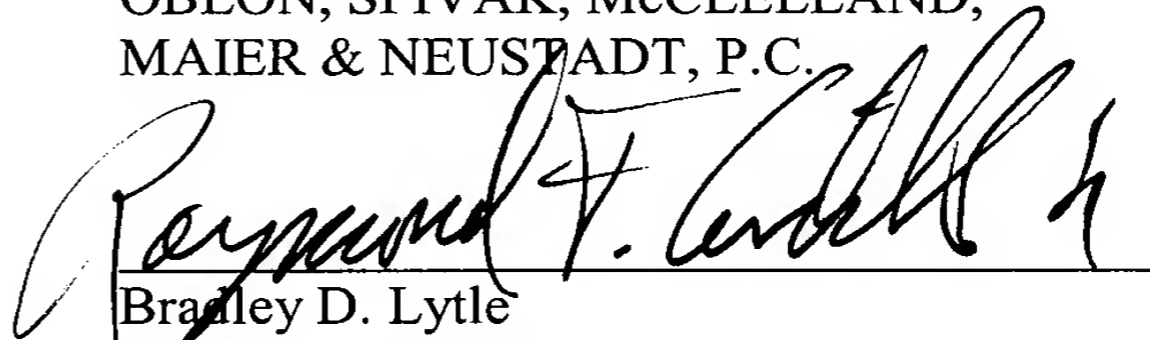
Turning to the rejection of Claims 2, 6, and 10 under 35 U.S.C. §103(a) as being unpatentable over Xu in view of Khaleghi and in further view of Peisa, the addition of Peisa cures none of the efficiencies noted above. As Claim 2 depends from above-argued independent Claim 1 and includes all the subject matter thereof, as Claim 6 depends from above-argued independent Claim 5 and includes all the subject matter thereof, and as Claim

10 depends from above-argued independent Claim 9 and includes all the subject matter thereof, dependent Claims 2, 6, and 10 patentably define over the applied references for at least the reasons noted above as to each of the corresponding independent claims. In addition, each of these dependent claims add further features not taught by these references considered alone or together in any proper combination. Accordingly, withdrawal of the improper rejection of Claims 2, 6, and 10 under 35 U.S.C. §103(a) as being unpatentable over Xu in view of Khaleghi and in further view of Peisa is also requested.

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Raymond F. Cardillo, Jr.
Registration No. 40,440